

Practitioner's Docket No. IB-1576CIP

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rockenberger, Joerg; Alivisatos, A. Paul;

Application No.: Unassigned  
Filed: November 21, 2000  
For: A PROCESS FOR MAKING SURFACTANT CAPPED NANOCRYSTALS

Group No.: Unassigned  
Examiner: Unassigned

Assistant Commissioner for Patents  
Washington, D.C. 20231

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NOV 07 2003  
TC 1700

STATEMENT UNDER 37 C.F.R. section 3.73(b)  
ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION

1. The assignee(s) of the entire right, title and interest hereby seek(s) to take action in the PTO in this matter.

CERTIFICATION UNDER 37 C.F.R. sections 1.8(a) and 1.10\*  
(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

37 C.F.R. section 1.8(a)

37 C.F.R. section 1.10\*

☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Address"  
Mailing Label No. \_\_\_\_\_ (mandatory)

TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office.

Date: 23 Feb 2001

Signature

Charles R. Nold Reg 46,470  
(type or print name of person certifying)

\*WARNING: Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).  
"Since the filing of correspondence under [section] 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this

### IDENTIFICATION OF ASSIGNEE

2. Name of assignee: The Regents of the University of California  
Type of assignee: University

### PERSON AUTHORIZED TO SIGN

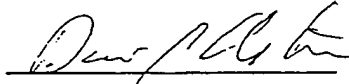
3. Name of person authorized to sign on behalf of assignee: David J. Aston  
Title of person authorized to sign: Manager, Patent Department

### BASIS OF ASSIGNEE'S INTEREST

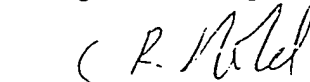
Ownership by the assignee is established as follows:

A.

1. An assignment from the inventor(s) of the matter identified above, a copy of which is included herewith.



Signature of authorized person  
David J. Aston  
Manager, Patent Department



Charles R. Nold  
Registration No. 46,470  
Lawrence Berkeley National Laboratory  
One Cyclotron Road  
MS 90-1121  
Berkeley, CA 94720  
510-486-6503  
Customer No. 008076

**ASSIGNMENT**

LENL Case No. IB-1576A

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S)

1. A. Paul Alivisatos      2. Joerg Rockenberger

hereby sells, assign(s) and transfer(s) to ASSIGNEE, The Regents of The University of California, a California Corporation, having its statewide administrative offices located at 1111 Franklin Street, 12<sup>TH</sup> Floor, Oakland, CA 94607-5200 and the successors, assigns and legal representatives of the ASSIGNEE all of its right, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

**TITLE: Process for making surfactant capped metal oxide nanocrystals, and products produced by the process**

and which is found in U.S. application serial no. 09/721,126, filed Nov. 22, 2000 and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, continuation-in-part, extension or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all rights under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

ASSIGNOR(S) further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may necessary or desirable to carry out the purposes thereof. Any attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, The Regents of The University of California.

Executed this:

Signature of Inventor(s)

\_\_\_\_ day of \_\_\_\_\_, 2001

3 day of October, 2003

A. Paul Alivisatos

  
Joerg Rockenberger

## ASSIGNMENT

LBNL Case No. **IB-1576A**

For good and valuable consideration, the receipt of which is hereby acknowledged, ASSIGNOR(S)

1. **A. Paul Alivisatos**      2. **Joerg Rockenberger**

hereby sells, assign(s) and transfer(s) to ASSIGNEE, The Regents of The University of California, a California Corporation, having its statewide administrative offices located at 1111 Franklin Street, 12<sup>TH</sup> Floor, Oakland, CA 94607-5200 and the successors, assigns and legal representatives of the ASSIGNEE all of its right, title and interest for the United States and its territorial possessions and in all foreign countries in and to, any and all improvements which are disclosed in the invention entitled:

**TITLE: Process for making surfactant capped metal oxide nanocrystals, and products produced by the process**

and which is found in U.S. application serial no. **09/721,126, filed Nov. 22, 2000** and any legal equivalent thereof in a foreign country, including the right to claim priority and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, continuation-in-part, extension or substitute thereof, and any reissue, reexamination or extension of said Letters Patent and all rights under all International Conventions for the Protection of Industrial Property;

ASSIGNOR(S) hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

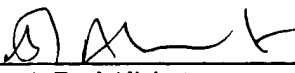
ASSIGNOR(S) further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation, or proceeding relating thereto and will promptly execute and deliver to ASSIGNEE or its legal representative any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue or enforce said application, said invention and said Letters Patent and said equivalents thereof which may necessary or desirable to carry out the purposes thereof. Any attorney of record is authorized and requested by the execution of this assignment to insert into this assignment the filing date and serial number of said application when officially known.

AND the ASSIGNOR(S) requests the Commissioner of Patents and Trademarks to issue said Letters Patent of the United States and any reissue or extension thereof to the ASSIGNEE, The Regents of The University of California.

Executed this:

Signature of Inventor(s)

19<sup>th</sup> day of August, 2003

  
\_\_\_\_\_  
**A. Paul Alivisatos**

\_\_\_\_ day of \_\_\_\_\_, 2001

\_\_\_\_\_  
**Joerg Rockenberger**

Please type a plus sign (+) inside this box ☐

PTO/SB/01 (12-97)

Approved for use through 9/30/00. OMB 0651-0032  
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>SUBSTITUTE DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)</b>	Attorney Docket Number	IB-1576A
	First Named Inventor	Alivisatos, A. Paul
	COMPLETE IF KNOWN	
	Application Number	09/721,126
	Filing Date	November 22, 2000
	Group Art Unit	1754
<input type="checkbox"/> Declaration Submitted with Initial Filing	OR	<input checked="" type="checkbox"/> Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)
Examiner Name		Bos, S.

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As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**Process for making surfactant capped metal oxide nanocrystals, and products produced by the process**

the specification of which (Title of the Invention)

☐ is attached hereto  
OR  
☒ was filed on (MM/DD/YYYY) **November 22, 2000** as United States Application Number or PCT International

Application Number **09/721,126** and was amended on (MM/DD/YYYY) **August 15, 2003** (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 356(b) of any foreign application(s) for patent or inventor's certificate, or 356(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input checked="" type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)
60/162,299	10/28/1999

☐ Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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## DECLARATION — Utility or Design Patent Application

I hereby claim the benefit under 35 U.S.C. 120 of any United States application(s), or 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application or PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number (if applicable)
09/702,219	October 30, 2000	

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority data sheet PTO/SB/02C attached hereto.

As a named inventor, I hereby appoint the following registered practitioner(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

☒ Customer Number **008076**

OR

☐ Registered practitioner(s) name/registration number listed below

Place Customer  
Number Bar Code  
Label here

Name	Registration Number	Name	Registration Number

☐ Additional registered practitioner(s) named on supplemental Registered Practitioner Information sheet PTO/SB/02C attached hereto.

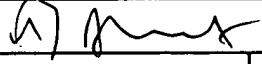
Direct all correspondence to: ☒ Customer Number or Bar Code Label **008076** OR ☐ Correspondence address below

Name					
Address					
Address					
City		State		ZIP	
Country		Telephone		Fax	

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: ☐ A petition has been filed for this unsigned inventor

Given Name (first and middle (if any))	Family Name or Surname
A. Paul	Alivisatos

Inventor's Signature				Date	8/19/03	PA	
Residence: City	Berkeley	State	CA	Country	United States	Citizenship	US
Post Office Address	5941 Estates Drive						
Post Office Address							
City	Oakland	State	CA	ZIP	94611	Country	United States

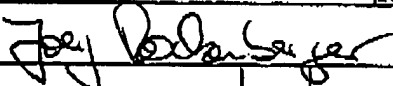
☒ Additional inventors are being named on the 1 supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto

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**DECLARATION****ADDITIONAL INVENTOR(S)  
Supplemental Sheet**Page 1 of 1

Name of Additional Joint Inventor, if any:				<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle (if any))				Family Name or Surname			
Joerg				Rockenberger			
Inventor's Signature						Date	10/14/03
Residence: City	Redwood City	State	CA	Country	United States	Citizenship	Germany
Post Office Address	23 Birch Street						
Post Office Address							
City	Redwood City	State	CA	ZIP	94086-6238	Country	United States
Name of Additional Joint Inventor, if any:				<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle (if any))				Family Name or Surname			
Inventor's Signature						Date	
Residence: City		State		Country		Citizenship	
Post Office Address							
Post Office Address							
City		State		ZIP		Country	
Name of Additional Joint Inventor, if any:				<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle (if any))				Family Name or Surname			
Inventor's Signature						Date	
Residence: City		State		Country		Citizenship	
Post Office Address							
Post Office Address							
City		State		ZIP		Country	

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